1631

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

James N. CAWSE

Group Art Unit: 1631

Application No.: 09/696,071

Examiner: Carolyn L. Smith

Filed: October 25, 2000

For: METHOD FOR DEFINING AN EXPERILMENTAL SPACE AND METHOD AND SYSTEM FOR CONDUCTING COMBINATORIAL HIGH THROUGHPUT SCREENING OF MIXTURES

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Box Fee Amendment
Washington, D. C. 20231

Sir:

In response to the Restriction Requirement mailed October 24, 2002, Applicant hereby elects Group I, claims 1 to 22 with traverse. Further, within Group I, Applicant elects Species A, claims 1 to 15 and 18 to 20, with traverse.

The Group II claims 23 to 25 are directed to an experimental space comprising mixture combinations that are used in the Group I method of claims 1 to 17 and system of claims 18 to 22. Hence, the subject matter of all the claims is sufficiently related that a search of any one Group encompasses a search for the subject matter of the other Group. Section 803 of the MPEP states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." All of the claims of the present application could be examined without serious burden in view of their close relationship. In order to avoid unnecessary delay and expense to the Applicant and duplicate examination by the Patent Office, it is respectfully requested that the restriction requirement be reconsidered and withdrawn.

Additionally, the Group II claim 23 defines an experimental space by an algorithm that is generic to the experimental space of the Group I claims 15 to 17 and 20 to 22. Hence claims 15 to 17 and 20 to 22 are linking claims between Groups I and II. If any of

the linking claims is allowed, rejoinder of the divided inventions must be permitted. See MPEP §809 and §818.03(d).

Additionally, it is improper for the Patent Office to refuse to examine the quaternary space claims (16 and 21) and the pentanary space claims (17 and 22) with the Group I claims. Section 803.02 of the MPEP provides:

> Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In re Harnish, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

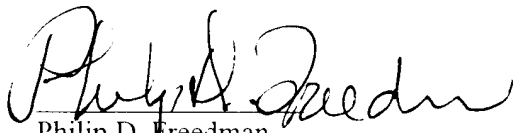
While Section 803.02 specifically addresses Markush groups, the principals of "common utility" and shared "substantial structural feature" apply in the present instance. All of the ternary, quaternary and pentenary experimental spaces are useable to define the second experimental space of claim 1 or claim 16 and all the spaces share the "structural feature" of definition by the generic algorithm of claim 23.

The claims can be easily amended to provide Markush recitation of a space "selected from a ternary space, a quaternary space and pentenary space." The members of this Markush group "(1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility." Compelling Applicant to provide a non substantive amendment to overcome the species requirement does not advance prosecution of this case. Applicant requests the PTO to withdrawal the species requirement without amendment.

The Drawings are objected to by the Draftsperson. Corrected formal drawings are attached along with a Letter to the Official Draftsperson. The corrected drawings should overcome the Draftsperson's objections.

For these reasons, and in order to avoid unnecessary delay and expense to the Applicant and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn and this Application be examined on its merits.

Respectfully submitted,



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